

REMARKS

Pending Claims

Claims 1-19 have been cancelled, without prejudice. New Claims 20-23 have been added and are pending.

The 35 U.S.C. §112 Rejection and Response

The §112 rejection of earlier pending Claims 10 and 14-19 is moot, as these claims have been cancelled.

The 35 U.S.C. §102(b) Rejections

Originally submitted, now cancelled, Claims 1-7, 9, 10 and 13-18 were rejected under §102(b) as being anticipated by Goddard (U.S. 5,842,932).

Original, now cancelled, Claims 1-4 and 7-10 were rejected under §102(b) as being anticipated by O'Flanagan (U.S. 4,601,472).

The 35 U.S.C. §103(a) Rejection

Original, now cancelled, Claims 11, 12, and 19 were rejected under §103(a) as unpatentable over Goddard in view of Sun (U.S. 6,450,894).

ANALYSIS OF THE PRIOR ART

Goddard (U.S. 5,842,932) does not disclose a putterhead and reflective member formed as one piece. Rather, Goddard mandates that his putterhead and reflective member comprised eight (8) separate items which are assembled together, i.e. a putterhead 22, a Velcro Strip 62, a Second Velcro Strip 64, a site registration element 54, a flat mirror element 40, a Third Velcro Strip on the back of flat mirror 40, a Fourth Velcro Strip 70, shaft engaging arm 72, and a dual sight pin assembly 50. Furthermore, Goddard requires that arm 72 be stabilized by force-fit clip engagement at 78 to the putter shaft.

It is readily apparent, where two (2) sets of hook and loop fasteners (Velcro Strips) are used that the stability of the flat mirror 40 would be greatly effected by external forces imposed during the golf showing and when the putterhead strikes the golf ball 26 and target 28. Inaccuracies would result and the sight mechanism would constantly require adjustment because of misalignment problems.

The complicated nature and multiple parts required by Goddard will not be cost effective, and is not reliable. Goddard does not suggest, teach, or make obvious the claimed limitations of the present invention, but rather teaches away from the claimed subject matter. Take particular note of Figures 1 through 3.

In reference to O'Flanagan (U.S. 4,601,472), large number of separate parts mandated teach away from the claimed invention, require expensive fabrication and assembly. O'Flanagan mandates that the sighting device 1 also comprised the ball striking surface 17. Thus, the putterhead 31 of O'Flanagan does not comprise a ball striking surface.

The sighting mechanism requires formation of an S-shaped element having precise surfaces 18, 3, and 5, provide apertures for screw fasteners 16, mandate bonding of two (2)

reflective surfaces 4 and 12 into position on surfaces 3 and f, and require bonding at channel 22 between the front flange 17 of the sighting device 1 and the putterhead 31. The combination putterhead/sighting device of O'Flanagan is not cost effective, requires fasteners, requires many parts, requires greater skill to use where two (2) mirrors 4 and 12 are involved and can be easily misaligned by loosening of the screws 16 or separation at channel 22 of the bonding agent from either the front flange 17 or the putterhead 31 or both. The fact that surface 17 of the sighting device strikes the ball during rise will likely cause the sighting device to be displaced and misaligned.

O'Flanagan is hostile, in its teachings, to the elements, set forth in the presently pending claims.

Sun (U.S. 6,450,849) is relevant only to the provision of additional weight to a putterhead. Since the present claims are not directed to adding weight to a putterhead, the teachings of Sun are moot to the presently pending claims.

The presently pending claims require in combination a putterhead with a ball striking surface and a reflective element having a fixed angular position, the two being formed as one piece. The reflective surface extends upwardly from the top of the integral putterhead and is not connected to the putter shaft nor is adjustable or alignable. The one piece putterhead/reflective member is without fasteners and without the capacity to adjusted or aligned. It is, therefore, a marvelous tool for both beginning golfers and experienced golfers since once the user becomes familiar with use of the putter comprising a one piece reflective member and putterhead, the rate of the skill development is significantly accelerated. The simplicity and reliability of the present invention, as currently claimed and as illustrated particularly in Figure 10, enhances its

availability and usefulness to a very large percentage of the purchasing in public, at a relatively low price.

Response to § 102 and § 103 Rejections

The currently pending claims patentably distinguish the present invention over Goddard, O'Flanagan, and Sun. The constraints of these references are pointed out above and cannot be construed as fully meeting nor rendering obvious the claims, as presently constituted.

With the foregoing in mind, and any further reliance on U.S.C. § 102 would be misplaced as such violates and would continue to violate the strict "every element" and "every function" requirements of U.S.C. § 102. Restated, § 102 may be applied to a claim only when "every element" and "every function" of the claim is found in the § 102 reference. For example, Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co. et. al., 221 USPQ 481, 485 (Fed. Cir. 1984), which emphasizes the "every element" requirement:

Anticipation requires the presence in a single prior art reference of each and every element of the claimed invention arranged as in the claim. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); SSIH Equip. S.A. v. USITC, 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the trier of fact [Examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the alleged anticipation reference. (Emphasis supplied.)

RCA Corp. v. Applied Digital Data Systems, Inc., 221 USPQ 385, 389 at fn. 5 (Fed. Cir. 1984) emphasizes the "every function" requirement:

Anticipation is determined by comparison of the reference with the claims. The claims here define the invention in terms of several specific "means plus function" elements. The limitations which must be met by an anticipatory reference are those set forth in each statement of the function. In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977). Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. (Emphasis added.)

The Federal Circuit confirmed the forgoing in Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988):

For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference. See Hybritech, Inc., v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986), cert. denied, 107 S.Ct. 1606 (1987). (Emphasis provided).

Similarly, the Ninth Circuit, in Scott v. Inflatable Systems, Inc., 222 USPQ 460, 461 (9th Cir. 1983), has held:

Anticipation is a technical defense which must meet strict standards. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 904, 185 USPQ 723, 725-26 (9th Cir. 1975). "Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference, there is no anticipation." Walter v. General Motors Corp., 362 F.2d 56, 68 (9th Cir. 1966). (Emphasis supplied.)

Here, as in Ex parte Murphy and Burford, 217 USPQ 479, 481 (Bd. App. 1982), the Examiner must consider all of the limitations of the claims. In this regard, Ex parte Murphy and Burford holds:

Since all limitations of a claim must be considered in determining the claimed subject matter . . . and it is error to ignore specific limitations distinguishing over the reference. In re Boe, 505 F.2d 1297, 184 USPQ 38 (CCPA 1974).

The Examiner, in making the § 102 rejections, failed to give appropriate weight to functional statements tied to specific structural limitations. This is error. As stated in Ex parte Bylund, 217 USPQ 492, 498 (Bd. of App. 1981):

. . . contrary to the Examiner's assertions, functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language. (Emphasis provided.)

The foregoing is wholly consistent with MPEP § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but . . . identity of terminology is not required. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Any attempt to read the present invention, as presently claimed, fully into any single reference does not comport in any way with the actual elements and functions disclosed in any reference of record. Withdrawal of § 102 as a basis for refusing allowance is, accordingly, appropriate and is courteously requested. It is not permissible to reconstruct, rearrange and alter a reference and still comply with the statutory requirements of 35 U.S.C. § 102.

Under § 103, where, as here, the prior art relied upon does not disclose or even hint, much less suggest the claimed combination, certain case law precedents come into play and control, as hereinafter set forth.

In addressing the question of whether or not the present invention is obvious or nonobvious under § 103, it is important that several factors be carefully weighed. First, case law requires that the Examiner engage in a "problem" analysis to determine whether or not the prior art addresses the same problem or a different problem than that which confronted the inventor prior to making the present invention. Hindsight reconstruction of the prior art based upon confidential access to the present application is not available to establish obviousness.

The problems confronting the present inventor are identified above. The inventor was able to solve his problems, whereas the prior art did not and certainly not in the same way.

If it is the Examiner's contention that the prior art addresses Applicant's problems and provide Applicant's solutions, it is respectfully requested that the Examiner identify the locations

in the references relied on where Applicant's problems and solutions are mentioned and addressed.

More specifically, "the relationship between the problem which the inventor . . . was attempting to solve and the problem to which any prior art reference is directed" is highly relevant. Stanley Works v. McKinney Manufacturing Co., 216 USPQ 298, 304 (Del. D.C. 1981). Thus, in analyzing the prior art under § 103 of the Act, we must clearly comprehend the problems addressed by the present inventor and such must be compared or contrasted, as the case may be, with the problem addressed by the prior art.

In respect to the applicability of any reference against claims of a pending U.S. patent application, the Examiner's attention is directed to In re Gibbons, 100 USPQ 398, where it is stated:

In considering the question of invention, it is necessary to determine whether or not the art relied upon contains adequate directions for the practice of the invention without resort to the involved application. (Emphasis added.)

The Examiner is courteously requested to find where in the references relied upon the requisite "adequate directions" are provided by the prior art relied on sufficient to reach the presently claimed combination. Since the prior art relied upon is neither intended nor able to achieve what the Applicant has achieved, as set forth in the presently pending claims, it is respectfully submitted that no directions whatever are provided by the references which would lead to the present invention, as claimed. Accordingly, the references should be accurately construed and withdrawn.

The pertinent primary inquiries in determining obviousness under § 103 are set forth in the Supreme Court's decision in Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The primary considerations set forth therein require (1) determination of the scope and

content of the prior art; (2) identification as to the differences between the prior art and the claims at issue; and (3) resolution of the level of ordinary skill in the pertinent art.

In respect to the scope of the prior art and the differences standards, the § 103 criteria provided by In re Winslow, 151 USPQ 48 (CCPA 1966) is that the prior art must address and provide the inventor's answer to the particular problem confronting an inventor. Here, the references relied upon by the Examiner do not propose, expressly or inferentially or by sound reasoning, the claimed solution to the inventor's aforementioned problem. Consequently, the references fail the Winslow § 103 test.

In Orthopedic Company, Inc. v. United States, 217 USPQ 193 (Fed. Cir. 1983), the Federal Circuit set forth a useful guide for determining the scope and content of the prior art. Orthopedic, at pages 196, 197, also focuses on the "problem" faced by the inventor:

In determining the relevant art . . . one looks at the nature of the problem confronting the inventor.

* * * *

. . . would it then be nonobvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit [the patent application before the Examiner] as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness. . . (Emphasis added.)

Applying the Federal Circuit's analysis in Orthopedic, it is clear the claims of the present application are allowable under § 103. Persons ordinarily skilled in the art would be charged only with an understanding of the express teachings of the individual analogous references. These references do not expressly teach or suggest the claimed combination. To read into the

references the inventor's present solution, necessarily requires hindsight reliance on Applicant's application, contrary to the instructions of Orthopedic.

The references relied upon teach away from the present invention. No reference even hints at the Applicant's combination. Hence, the references are not available to defeat the pending claims here, under § 103, giving effect to Orthopedic. If the Examiner persists in the § 103 rejection, it is again courteously requested that the locations in the references which propose or suggest Applicant's claimed combination be identified.

The Federal Circuit has also said that "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." (Emphasis provided). Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, 221 USPQ 481 (Fed. Cir. 1984). The above standard was reiterated in Fromson v. Advance Offset Plate, Inc., 225 USPQ 26 (Fed. Cir. 1985).

Clearly, the present combination as set forth in the present claims are not obvious "as a whole" from the references.

The Board of Appeals confirms that hindsight reliance through confidential access to an application being examined, in an attempt to arrive at the claimed invention under 35 U.S.C. § 103, is negated. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. of App. 1985), which states:

To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (Emphasis supplied).

Here, there is no express or implied suggestion in the references that the claimed combination could or should be used to solve the problem facing the present inventor. There is

no convincing line of reasoning available in respect to the references by which an artisan would, as a matter of obviousness, have arrived at the present claimed invention absent any suggestion, express or implied, in the reference of the solution fashioned by the present inventor, as set forth in the claims.

Here, the indication of nonobviousness is substantial, under the primary considerations of Graham, i.e., the basic irrelevance of the prior art to the claimed combination, failure of others to provide the inventor's solution both before and after the present invention and the fact that others have not foreseen the inventor's solution even though the prior art teachings have been around for some time. A determination of nonobviousness is compelling.

Nonobviousness follows from Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ 2d 1593, 1605 (Fed. Cir. 1987):

Indeed, that the elements noted by the court lay about in the prior art available for years to all skilled workers, without, as the court found, suggesting anything like the claimed inventions, is itself evidence of nonobviousness.
(Emphasis provided.)

Where, as here, the prior art is simply incapable of functioning as required by the present claims and achieving what is achieved by the present invention, § 103 rejections cannot be sustained. Here as in Ex parte Gould, 231 USPQ 943, 946 (Bd. App. 1986):

... the examiner has failed to make out a prima facie case that ... [the prior art] achieved or is capable of achieving ... [what is achieved by the present invention] we are constrained to reverse the rejections based on ... [the prior art]. (Emphasis supplied.)

For the Examiner to assign attributes to the references which do not, in fact, exist and to entirely discount the critical language within the claims which is directed to Applicant's combination does not comply with the Graham requirement of [objectively] identifying the

differences between the claimed invention and the prior art. Under In re Wood and Eversole, 202 USPQ 171, 174 (CCPA 1979), it was necessary:

... to more closely approximate the reality of the circumstances surrounding the making of an invention. . . . (Emphasis added.)

A brief examination of "hindsight" law as handed down by the Federal Circuit superimposed upon the facts of this case will be helpful.

See, for example, Union Carbide Corp. v. American Can Co., 220 USPQ 584, 591 (Fed. Cir. 1984):

... helps us to guard against slipping into hindsight rather than viewing the question as the inventor at the time the patented device was developed." (Emphasis provided.)

The hindsight approach was further criticized in W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. (Emphasis added.)

The Federal Circuit repeated its prohibition against "hindsight" in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434, 1438, 1439 (Fed. Cir. 1988), where it was held:

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

* * * *

There is no suggestion in any individual prior art reference of such a combination of location and configuration nor is it suggested by the prior art as a whole. ([I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention).

* * * *

. . . the district court . . . does not show that there is any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination.

* * * *

In view of the antithetical principles of operation and the absence of any teaching or suggestion to combine these prior art devices, there is no apparent basis for the district court's conclusion that it would have been obvious to one skilled in the art to make the combination. (Emphasis added; citations omitted.)

The Uniroyal analysis applies here as well.

Clearly, the present invention is not obvious, based upon the analysis of primary considerations mandated by the U.S. Supreme Court in Graham.

The rejection under § 103 has a further malady. It fails to give any weight to the fact that the prior art patents teach away from the simplicity and reliability of the present invention. Here, as in In re Hedges, et al., 228 USPQ 685, 687 (Fed. Cir. 1986):

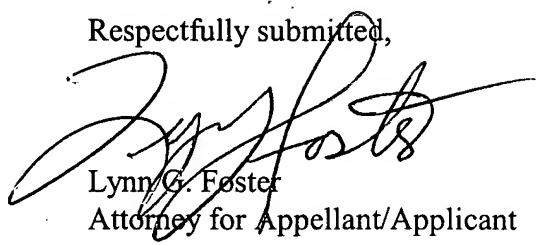
"The totality of the prior art disclosures leads substantially away from the claimed invention". We agree with . . . [Applicant] that the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art". (Emphasis added; citations omitted.)

For the reasons stated, the § 103 rejections cannot be sustained.

CONCLUSION

Given the foregoing presently pending Claims 20-23 are in condition for allowance and such action is courteously invited.

Respectfully submitted,



Lynn G. Foster
Attorney for Appellant/Applicant

602 East 300 South
Salt Lake City, Utah 84102
Telephone (801) 364-5633